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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/817,926	03/27/2001	Toshiro Ishimura	14428	3952
<div>7590 12/09/2008</div> <div>Paul J. Esatto, Jr. Scully, Scott, Murphy & Presser 400 Garden City Plaza Garden City, NY 11530</div> <div>EXAMINER NGUYEN, LUONG TRUNG</div> <div>ART UNIT 2622 PAPER NUMBER</div> <div>MAIL DATE 12/09/2008 DELIVERY MODE PAPER</div>				

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/817,926

Applicant(s)

ISHIMURA ET AL.

Examiner

LUONG T. NGUYEN

Art Unit

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Amendment filed on 8/28/2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 4, 5, 9, 14, 15, 21 and 23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4, 5, 9, 14, 15, 21 and 23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election of Species I, Figures 1, 2, 4 in the reply filed on 1/18/2005 is acknowledged.

Response to Arguments

2. Applicant's arguments filed on 08/28/2008 have been fully considered but they are not persuasive.

In re page 11, Applicants argue that Nishimura does not teach or suggest a freeze button for freezing a motion image displayed on the display device, as provided in amended independent claim 1.

In response, regarding claim 1, Applicants amended claim 1 with limitation "an operation section including a freeze button for freezing a motion image displayed on the display device, and a recording button for instructing start of image recording." The Examiner considers that claim 1 as amended still does not distinguish from Nishimura in view of Kobayashi and Kaku. Kobayashi teaches an endoscope includes a video camera 46, which is provided with remote control switches (i.e., an operation section), including freeze switch 47 (i.e., a freeze button), release switch 48, and VTR switch 49 (i.e., a recording button, figure 4-5, column 2, lines 63-68, column 4, lines 60-65, column 5, lines 30-49, column 5, line 65 to column 6, line 8).

In re page 11, Applicants argue that Nishimura does not teach or suggest a control circuit including a function for switching the setting of the control circuit from a motion image recording mode for recording the motion image when the motion image is displayed on the display device to a still image recording mode for recording a still image when the motion image displayed on the display device is frozen using the freeze button, as provided in amended independent claim 1.

In response, regarding claim 1, the Applicants amended claim 1 with limitation “*a function for switching the setting from the motion image recording mode to a still image recording mode for recording a still image when the motion image displayed on the display device is frozen using the freeze button.*” The Examiner considers that claim 1 as amended still does not distinguish from Nishimura in view of Kobayashi and Kaku. Nishimura discloses switching means 36, which is used for switching between motion-picture and freeze display mode (figure 1, column 5, lines 9-29); upon depress a freeze button, a freeze-image of a subject is instantly displayed on the monitor device and is stored in the still memory circuit 34 and is simultaneously recorded on external memory 38 (figure 1, column 4, line 49—column 5, line 40; column 6, lines 15-25), which corresponds to “*a still image recording mode for recording a still image when the motion image displayed on the display device is frozen using the freeze button.*”

Nishimura does not disclose *a motion image recording mode*. However Kaku teaches this feature. Kaku teaches an electronic camera, in which the system controller carries out a monitor mode in step S1, motion images are displayed on the monitor 9; if motion image record mode is selected (step 7), motion image recording process is executed (step 11), see figure 3, column 4, lines 20-65.

In page 12, Applicants argue that Kaku does not teach or suggest a control circuit including a function for switching the setting of the control circuit from a motion image recording mode for recording the motion image when the motion image is displayed on the display device to a still image recording mode for recording a still image when the motion image displayed on the display device is frozen using the freeze button, as provided in amended independent claim 1.

In page 13, Applicants argue that Kobahashi does not teach or suggest a control circuit including a function for switching the setting of the control circuit from a motion image recording mode for recording the motion image when the motion image is displayed on the display device to a still image recording mode for recording a still image when the motion image displayed on the display device is frozen using the freeze button, as provided in amended independent claim 1.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Claim Objections

3. Claims 1, 4-5, 9, 14-15, 21, 23 are objected to because of the following informalities:
Claim 1 (line 18), "the setting" should be changed to --a setting--.

Claim 1 (line 22), "when image recoding" should be changed to --when the image recording--.

Claim 5 (line 5), "image recoding" should be changed to --the image recording--.

Claim 9 (line 6), "graphic image data" should be changed to --the graphic image data--.

Claim 21 (line 1), "an endoscope, of" should be changed to --an endoscope of--.

Claim 21 (line 11), "the frozen images" should be changed to --frozen images--.

Claim 21 (line 12), "the setting" should be changed to --a setting--.

Claims 4-5, 9, 14-15 are objected as being dependent on claim 1.

Claim 23 is objected as being dependent on claim 21.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 5, 21, 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nishimura (US 5,270,810) in view of Kobayashi (US 4,755,873) further in view of Kaku (US 6,968,119).

Regarding claim 1, Nishimura discloses an image recording apparatus for an endoscope comprising:

display device on which the image is displayed (monitor device, figure 1, column 4, lines 1-5);

a control circuit including:

a function for switching the setting from the motion image to a still image recording mode for recording a still image when the motion image displayed on the display device is frozen using the freeze button (Nishimura discloses switching means 36, which is used for switching between motion-picture and freeze display mode, figure 1, column 5, lines 9-29; upon depress a freeze button, a freeze-image of a subject is instantly displayed on the monitor device and is stored in the still memory circuit 34 and is simultaneously recorded on external memory 38, figure 1, column 4, line 49—column 5, line 40; column 6, lines 15-25, which corresponds to *“a still image recording mode for recording a still image when the motion image displayed on the display device is frozen using the freeze button”*).

a function for recording the still image onto the recording medium in the still image recording mode when image recording is instructed using the recording button of the operation section in a state where the motion image displayed on the displayed device is frozen using the freeze button (upon depress a freeze button, a freeze-image of a subject is instantly displayed on the monitor device and is stored in the still memory circuit 34 and is simultaneously recorded on external memory 38, figure 1, column 4, line 49—column 5, line 40; column 6, lines 15-25).

Nishimura fails to specifically disclose an operation section including a freeze button for freezing a motion image displayed on the display device, and a recording button for instructing start of image recording. However, Kobayashi teaches an endoscope includes a video camera

46, which is provided with remote control switches (an operation section), including freeze switch 47 (a freeze button), release switch 48, and VTR switch 49 (a recording button, figure 4-5, column 2, lines 63-68, column 4, lines 60-65, column 5, lines 30-49, column 5, line 65 to column 6, line 8). Therefore, it would have been obvious to one of ordinary skill in the art to modify the device in Nishimura by the teaching of Kobayashi in order to obtain an endoscope device which allows an operator performs an accurate switching operation easily and quickly, without regard to the type of endoscope used (column 6, lines 1-7).

Nishimura and Kobayashi fail to specifically disclose a function which is set to a motion image recording mode for recording the motion image when the motion image is displayed on the display device, and records the motion image onto a recording medium when image recording is instructed using the recording button of the operation section.

However Kaku teaches these features. Kaku teaches an electronic camera, in which the system controller carries out a monitor mode in step S1, motion images are displayed on the monitor 9; if motion image record mode is selected (step 7), motion image recording process is executed (step 11), see figure 3, column 4, lines 20-65.

Therefore, it would have been obvious to one of ordinary skill in the art to modify the device in Nishimura and Kobayashi by the teaching of Kaku in order to obtain an endoscope device, which recording both motion and still image. This allows a user can review both motion and still image.

Regarding claim 5, Nishimura and Kobayashi fail to specifically disclose a motion image compressing processing circuit that compresses the motion image, and a still image compressing

processing circuit that compresses the still image, wherein the control circuit performs image recording by compressing the motion image or the still image according to the displayed image displayed on the displayed device.

However, Kaku teaches an electronic camera, which includes a motion image compressing processing circuit that compresses a motion image and a still image compressing processing circuit that compresses a still image (figures 4-7, column 8, lines 36-59). Therefore, it would have been obvious to one of ordinary skill in the art to modify the device in Nishimura and Kobayashi by the teaching of Kaku in order to increase the capacity of the memory to store more images.

Regarding claim 21, claim 21 is a method claim of apparatus claim 1, therefore, see Examiner's comments regarding claim 1.

Regarding claim 23, Nishimura discloses a still image updating step of, when a displayed image on the displayed device is judged to have been switched to the motion image, updating the still image, and the still image recording step of setting the image recording mode to the still image recording mode for recording the still image updated (Nishimura teaches a data renewing signal generator 26 for renewing still image, figure 1, column 3, lines 64-68, column 6, lines 42-60).

6. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nishimura (US 5,270,810) in view of Kobayashi (US 4,755,873) and Kaku (US 6,968,119) further in view of Yamagishi et al. (US 7,339,620).

Nishimura, Kobayashi and Kaku fail to specifically disclose an information memory for switching information on the displayed image displayed on the display device when the motion image displayed on the display device is frozen using the freeze button, and the control circuit judges whether a selected state is the still image or the motion image by referring to the switching information stored in the information memory.

However, Yamagishi et al. teaches an image sensing apparatus 100, which captures and stores still or moving images (figure 1, column 4, lines 13-21). The image sensing apparatus 100 comprises single/continuous shot flag, which is stored in the internal memory of the system control circuit 50 or memory 52; if the single shot is selected, the control circuit 50 sets a single/continuous shot flag to indicated single shot mode (still image, step S112); if the continuous shot is selected, the control circuit 50 sets a single/continuous shot flag to indicated continuous shot mode (motion image, step S113), see figures 1-4, column 9, line 59 – column 10, line 8. After that the single shot or continuous shot is stored in recording medium 200 or 210 in step S138, figure 4, column 14, lines 10-16.

Therefore, it would have been obvious to one of ordinary skill in the art to modify the device in Nishimura, Kobayashi and Kaku by the teaching of Yamagishi et al. in order to inform the user the shot mode of the image sensing apparatus: single shot mode or continuous mode. This allows the user to record image at a desired mode.

7. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nishimura (US 5,270,810) in view of Kobayashi (US 4,755,873) and in view of Kaku (US 6,968,119) further in view of Wright et al. (US 5,825,982).

Regarding claim 9, Nishimura, Kobayashi and Kaku fail to specifically disclose a graphic processor for producing graphic image data in response to an instruction from the control circuit, wherein, when the motion image displayed on the display device is frozen using the freeze button, an image signal of the still image displayed on the display device is superimposed to graphic image data generated in the graphic processor and outputted to the display device.

However, Wright et al. discloses the graphic overlay processor 58, which generates a series of static graphic images 64-70 that overlay onto the video image 62 displayed by the monitor 18 (figure 4, column 3, lines 62-67). Therefore, it would have been obvious to one of ordinary skill in the art to modify the device in Nishimura, Kobayashi and Kaku by the teaching of Wright et al. in order to obtain a device, which includes an interface that allows a surgeon to remotely control surgical device and conditions of an operation room (column 1, lines 42-45).

8. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nishimura (US 5,270,810) in view of Kobayashi (US 4,755,873) and in view of Kaku (US 6,968,119) further in view of Sakai et al. (US 5,260,795).

Regarding claim 14, Nishimura, Kobayashi and Kaku fail to specifically disclose a voice recording processing circuit that records a voice signal. However, Sakai et al. teaches a camera includes a microphone 21 for recording sounds (column 2, lines 35-49). Therefore, it would have been obvious to one of ordinary skill in the art to modify the device in Nishimura,

Kobayashi and Kaku by the teaching of Sakai et al. in order to obtain a device which has the ability of recording sound together with recording image data.

9. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nishimura (US 5,270,810) in view of Kobayashi (US 4,755,873) and in view of Kaku (US 6,968,119) further further in view of Takeuchi et al. (US 6,243,531).

Regarding claim 15, Nishimura, Kobayashi and Kaku fail to specifically disclose wherein the remaining storage capacity of the recording medium, which is available for storage of information, is detected to be indicated. However, Takeuchi et al. teaches a recording apparatus includes a display circuit 116 displays the number of remaining recordable still images (figure 9, column 7, line 62 to column 8, line 5). Therefore, it would have been obvious to one of ordinary skill in the art to modify the device in Nishimura, Kobayashi and Kaku by the teaching of Takeuchi et al. in order to allow the user know the number of recordable still images by seeing the display (column 8, lines 8-13).

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to LUONG T. NGUYEN whose telephone number is (571) 272-7315. The examiner can normally be reached on 7:30AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, DAVID L. OMETZ can be reached on (571) 272-7593. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/David L. Ometz/
Supervisory Patent Examiner, Art Unit
2622

/L. T. N./
12/05/08